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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Claims 1-37, 77, 83-94, 97-108, 119, 121 and 123 are all the pending claims for this application.
2. Claims 1-37, 77, 84-87, 93, 94, 97, 101-108 are withdrawn from examination.
3. Claims 83, 88-92, 98-100, 119, 121 and 123 are all the pending claims under examination with targeting units for a ligand species of soluble CD40 ligand and the chemokines, RANTES and MIP-1 α , and the species of antigenic units for an antigenic scFv.
4. This Office Action is **final**.

Rejections Maintained

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. The rejection of Claims 83, 88-92, 98-100, 119, 121 and 123 under 35 U.S.C. 103(a) as being unpatentable over by Herman (US 20050069549; published March 31, 2005; filed Jan 14, 2003; cited in the PTO 892 form of 11/7/06) in view of Slavin-Chiorini et al. (Int. J. Can. 53:97-103 (1993)) is maintained.

The rejection was set forth in the Office Action of 10/30/09 as follows:

"Claims 83, 88-92, 98-100, 119 and 121-123 are interpreted as being drawn to an isolated nucleic acid encoding a monomer unit of a recombinant antibody-based dimeric molecule, said nucleic acid encoding an antigenic unit, a dimerization motif and a targeting unit operably connected to encode said monomer unit, and wherein said antibody-based dimeric molecule comprises two of said monomer units connected through said dimerization motif, said dimerization motif comprising an Ig hinge region and a Cy3 domain of each monomer unit, wherein each Ig hinge region contributes to dimerization via disulfide bridging to the other Ig hinge region and each Cy3 domain contributes to dimerization via hydrophobic interactions to the other Cy3 domain, and wherein each of said monomer unit comprises a targeting unit for an antigen presenting cell and an antigenic unit, wherein said targeting unit and said antigenic unit in the monomer unit are separated by said dimerization motif and wherein said monomer units each lack a CH2 domain (Claim 83), wherein at least one of said targeting unit is a ligand (Claim 88), and wherein said ligand is soluble CD40 ligand or a chemokine (Claim 89), wherein said ligand is a chemokine (Claim 90), wherein said chemokine is RANTES or Macrophage Inflammatory Protein 1 alpha (Claim 91), wherein said chemokine is MIP-1a (Claim 92), wherein said targeting unit have the ability to target a chemokine receptor (Claim 98), wherein at least one of said antigenic unit is an antigenic scFv (Claim 99), wherein said antigenic scFv has VL and VH chains from a monoclonal Ig produced by myeloma or lymphoma (Claim 100).

Claim 119 is drawn to a vector comprising the nucleic acid according to claim 83.

Claim 121 is drawn to a composition comprising a nucleic acid according to claim 83 or a vector comprising the nucleic acid according to claim 83, in combination with a physiologically acceptable diluent or carrier.

Claim 122 is drawn to a composition comprising a cell of the cell line according to claim 120, in combination with a physiologically acceptable diluent or carrier.

Claim 123 is drawn to a kit for preparation of a recombinant antibody-based molecule encoded by the nucleic acid according to claim 83, the kit comprising a nucleic acid according to claim 83.

The nucleic acid encoding a monomer comprising the (targeting unit – dimerization motif (Ig hinge and Cy3)-antigenic unit) or (antigenic unit- dimerization motif (Ig hinge and Cy3)- targeting unit) was prima facie obvious at the time of the invention over Herman and Slavin-Chiorini.

Herman discloses nucleic acids, vectors comprising nucleic acids and vector transfected cell lines encoding a multispecific ligand comprising at least two different binding specificities for different target ligands comprising any combination of one or more antibody fragments or recombinant reconstructions (scFvs) of antibodies including tetraspecific antibody formats and fusions of the antibody to other functional moieties (eg. toxins, cytokines, chemokines, streptavidin, adhesion molecules) [0107-0108], where the multispecific ligand comprises an Fc portion and an Ig hinge portion. An Fc portion may be a partial Fc portion (eg. minibody-CH3) [0069]. The amino acid composition (including length) of the hinge portion should provide means for linking two typically heavy chains, eg. through one or more disulfide bonds, leucine zipper, fos-jun, optionally a flexible hinge typical of an IgG1 or having one to several more disulfide bonds eg. IgG3) [0116]. The binding characteristics of the multispecific ligand e.g., scfv, is that the target ligand is of sufficient affinity to effectively bind or remain bound without the other unit being available for simultaneous binding [0119]. An example of one monomer comprises a first ligand moiety which recognizes a first target ligand that is over-expressed on a disease associated entity (for example a diseased or disease-causing or mediating cell or infectious agent) and a second ligand binding moiety that recognizes a target ligand and wherein the first target ligand is characterized in that it does not lend itself to facilitating or permitting internalization of the second ligand binding moiety [0122].

Herman discloses the heterofunctional ligand is fused or conjugated to a therapeutic agent or a moiety that binds to a ligand which effects binding to another immune cell, for example a T cell or APC. The multispecific ligand is

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a tetraspecific antibody or the first moiety binds to but is incapable of modulating the activity of an immune cell and the second moiety modulates the activity of the immune cell independently of the first moiety [0137].

Herman discloses a multispecific ligand which comprises a first ligand binding moiety which neutralizes a ligand eg. a natural ligand such as a chemokine and a second ligand binding moiety which binds to a cell marker associated with a cell [0138]. Examples of proteins which are targeted by multispecific ligand (targeting unit) include CD40 [0164], MIP-1 alpha and RANTES [0428]. Herman discloses a multispecific ligand comprising an anti-idiotypic antibody (antigenic unit) so as to facilitate a desired immune response eg. vaccination type responses [0172, 0252]. For one embodiment, Herman discloses a multispecific ligand containing an immunocytokine containing an anti-idiotypic antibody component and a cytokine component [0018]. Herman discloses nucleic acids, expression vectors and host cells expressing the vectors to produce a multispecific ligand [0241- 0298; 0314-0319]. Herman discloses a kit comprising one or more polynucleotides comprising one or more DNA sequences, where the DNA sequences encode one or more polypeptides which are sufficient to constitute a multispecific ligand as defined in any of the preceding paragraphs [0424]. Herman discloses the element of CH2 domain being optional and the element of CH3 domain being optional whereas Slavin-Chiorini discloses deleting the CH2 domain altogether and maintaining a CH3 constant domain for an Ig molecule.

Slavin-Chiorini discloses the long-felt need to obtain recombinant Ig molecules with rapid plasma clearance and little or no ability to elicit a HAMA response for use in diagnostic or therapeutic regimens, and that by deleting the CH2 domain of an intact Mab, the ordinary artisan could reasonably expect to obtain these results for murine and chimeric antibodies (p. 97, Col. 1, ¶1 and 3). The Ig molecule is shown in Figure 1 comprising a CH2 constant region deletion, an intact hinge region with a linker peptide bridging the CH1 and CH3 constant domains. Slavin-Chiorini discloses there is a reduction in disulfide bond formation between the heavy chains for the CH2 domain deletion, but that presence of the peptide linker may contribute to the stability of the Ig molecule. Slavin-Chiorini discloses that these alternative forms of Ig molecules demonstrate faster clearance rate, more rapid tumor targeting and lack of metabolic uptake in normal tissues which provide advantages over the full molecules.

The ordinary artisan would have been motivated and assured of success in having produced a nucleic acid encoding a monomer comprising the (targeting unit – dimerization motif (Ig hinge and C γ 3)- antigenic unit) or (antigenic unit- dimerization motif (Ig hinge and C γ 3)- targeting unit) based on the combined disclosures of Herman and Slavin-Chiorini. Herman teaches all of the elements for designing such a construct, for example, fusion proteins comprising a immunocytokine having an anti-idiotypic antibody component and a cytokine component fused therewith or conjugated thereto, or ligands including bispecific antibodies, antibody fusions/ conjugates eg. where the immune affecting antibody portion or other moiety is conjugated, fused etc. to an antibody or fragment that binds to an entity associated marker [0223]. Herman teaches making a "divalent immunoconjugate" by attaching therapeutic agents to a carbohydrate moiety and to a free sulfhydryl group [0338]. Accordingly, Herman teaches an example of a bispecific antibody comprising two dAb components comprising linked via a linker having at least part of a constant region for fusion for example to a toxin (eg. at least a partial hinge region, and preferably also at least a partial CH2 domain (optionally also at least a partial CH3 domain) [0345]. Herman requires the hinge region, does not necessarily require the CH2 domain although preferable, and may include the CH3 domain, which is considered to read on the constructs in view of all of the other elements taught (and discussed above) by Herman as possible combinations for constructs. The ordinary artisan would have been motivated to have deleted the CH2 domain entirely from the construct of Herman where it was well known according to Slavin-Chiorini at the time of the invention, that the CH2 domain contains many of the effector functions for the constant region of an Ig and the sole N-linked glycosylation site in human C γ 1. Eliminating the CH2 domain would render the Ig into a less complex molecule in terms of reduced immunogenicity, increased target specificity and rapid clearance from circulation. Maintaining a linker and CH3 domain according to Slavin-Chiorini at the time of the invention would stabilize the expressed molecular complex with respect to binding (It is not a requirement that the Examiner establish that the cited art contains all the elements of the rejected claim, as the analysis under 35 U.S.C. § 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR, 550 U.S. at 418.).

The ordinary artisan would have been assured of reasonably success in having produced the nucleic acid where each of the reference taught the reagents and steps for making recombinant Ig-like molecules with bi-specific binding properties, to maximize the stability of an expressed protein monomer in pairwise formation via a linker and CH3 domain, and to reduce non-specific biological effects for an Ig-like molecule by deleting the CH2 domain. For all of these reasons, the claims were prima facie obvious at the time of the invention."

The rejection was maintained in the Office Action of 6/1/10 as follows:

"Applicants allegations on pp. 13-19 of the Response of 3/1/10 have been considered and are not found persuasive.

a) Applicants allege the encoded constructs according to the present claims need not include an antigen binding site of an antibody. Rather, the important functionalities of the two units (the antigenic unit and the targeting unit) are their ability to function as an antigen (which can induce antibodies) and to target the homodimeric molecule to a relevant cell (for instance an antigen presenting cell). The homodimeric molecules are useful as vaccine agents, and this is also the case for the claimed nucleic acids (when used in nucleic acid vaccination) but the nucleic acids may also be used in expression vectors for recombinant production of the homodimeric molecules.

Response to Arguments

Unless the examiner is in need of new prescription eye glass lenses, then it is not understand how Applicants attorney can read the required limitation out of the claims, i.e., the targeting unit is an antibody-based molecule (e.g., a scfv) (see Claims 84-87). In addition, it is not understand how Applicants attorney can read the required limitation out of the claims, i.e., the antigenic unit is an antibody-based molecule (e.g., a scfv) (see Claims 99 and 100). Applicants' attorney would have the Office believe that the claims are distinguishable over Herman and Slavin-Chiorini because they do not require an antigen binding site of an antibody, when the instant pending claims specifically make this a requirement of the construct irrespective of whether the molecule is a vaccine. When the invention is taken as whole, then a given species of construct could conceivably comprise two antibody-based antigen binding units, one for the targeting unit and the other for the antigenic unit.

b) Applicants allege "Herman... does not enable nucleic acids encoding any and all multispecific constructs. In particular, Herman does not at all address production of antibody-based dimeric molecules comprising two monomer units encoded by the same nucleic acid...."

Response to Arguments

MPPE 2144.02 states in part: "In certain< circumstances >where appropriate<, ** an examiner >may< take official notice of facts not in the record..., however such rejections should be judiciously applied." Here the examiner submits that Applicants attorney statement of facts asserted to be well-known, or to be common knowledge in the art are not capable of instant and unquestionable demonstration as being well-known. Accordingly, Applicants are requested to supply documentary evidence to support the conclusion that the ordinary artisan would not be enabled to express two monomer units from the same nucleic acid as alleged by Applicants attorney.

c) Applicants allege "A rapid plasma clearance rate (as taught by Slavin-Chiorini) is exactly the opposite of what is aimed at in the present claims and specification, wherein a prolonged serum half-life (i.e., slow plasma clearance) of the antibody-like expression products is desired..."

Response to Arguments

The examiner resubmits that the discussion in the rejection as regards Slavin-Chiorini deleting CH2 domains in order to achieve a rapid clearance was to set forth grounds for a prima facie motivation to delete the CH2 domain. Notably, Applicants have ignored the second grounds for motivation to delete the CH2 domain discussed in Slavin-Chiorini, which was to reduce the HAMA. Instead, Applicants conduct a lengthy and quite irrelevant discourse on why prolonged serum half life is better than rapid clearance and further urge the Office to believe that prolonged serum half life is inherent to their instant claimed invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., prolonged serum half-life) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The rejection was maintained in the Office Action of 1/25/11 as follows:

"Applicants allegations on pp. 12-17 of the Response of 10/26/10 and the 1.132 Declaration of Dr. Sally Ward Ober filed with the Response of 10/26/10 have been considered and not found persuasive. Applicants and the Declarant allege the two cited reference do not provide the motivation to modify the constructs of the respective disclosures to obtain the instant claimed construct because Herman teaches prolonging the serum half-life of the multispecific ligand, whereas, Slavin-Chiorini teaches reduces the plasma half-life for Mabs.

Response to Arguments

The examiner submits that the properties of antibody serum/blood clearance and antibody half-life are all separately defined parameters commonly used in drug studies. See the attached on-line dictionary definitions for each phrase:

Antibody half-life: mean survival time for antibody molecules;
Clearance: rate of removal from blood.

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Finally, the examiner submits that Herman is not limited as only teaching prolonging "serum half-life" for the antibody construct where Herman teaches examples of "half-life".

"Methods of prolonging the half-life of antibodies, producing bispecifics, scFvs and dsFvs and altering Fc effector function are well known and noteworthy references include U.S. Pat. No. 6,277,375, U.S. Pat. No. 5,869,046, U.S. Pat. No. 5,624,821, U.S. Pat. No. 6,096,871, U.S. Pat. No. 4,479,895, U.S. Pat. No. 6,207,804, U.S. Pat. No. 5,681,566, U.S. Pat. No. 5,864,019, U.S. Pat. No. 5,869,620, U.S. Pat. No. 6,025,165; U.S. Pat. No. 6,027,725; U.S. Pat. No. 6,239,259; U.S. Pat. No. 6,121,424; WO00/09560; U.S. Pat. No. 6,420,140" [0104]; and

"In addition, those of skill in the art will recognize numerous possible variations of the conjugation methods. For example, the carbohydrate moiety can be used to attach polyethyleneglycol in order to extend the half-life of an intact antibody, or antigen-binding fragment thereof, in blood, lymph, or other extracellular fluids" [0338].

Herman teaches examples of antibody "clearance"

"...(with respect to removing disease associated antibodies from circulation see for example a bispecific dsDNAx monoclonal antibody construct for clearance of anti-dsDNA IgG in systemic lupus erythematosus. J Immunol Methods. 2001 Feb. 1; 248(1-2):125-138). (see also, for example, U.S. Pat. No. 5,968,510 with respect to antibody-CTLA-4 fusion proteins for use in binding to various target ligands)" [0162];

And selecting antibody constructs for the following properties: "avidity, affinity and other elements of design including size, blood clearance additional functionality etc..." [0186].

Slavin-Chiorini teaches measuring serum clearance of the antibodies and half-life measured as RI in the form of tissue localization. Slavin-Chiorini teaches the CH2-domain deleted MAb localizes to tumors earlier and clears from blood faster than the labeled parent Mab (p. 101, Col. 2, ¶2). Slavin-Chiorini teaches:

"Further testing is required to determine the potential clinical utility of the cB72.3ΔCH2 in the light of its lower tumor binding as compared with cB72.3. However, the faster clearance rate, more rapid tumor targeting and lack of metabolic uptake in normal tissues demonstrated with the iodine-labeled CH2 domain-deleted cMAb may be an advantage for certain clinical protocols. For example, an antibody with these characteristics may be useful in instances in which the exposure of normal tissues to a radionuclide conjugated to an MAb needs to be minimized. A cMAb with a faster clearance rate may also be less likely to elicit an immune response in a patient, thereby allowing multiple and/or higher dosages of a cMAb to be administered. The cMAbΔCH2 may also be optimal for conjugation with radioisotopes with shorter half-lives, and allow for the efficient use of the intraoperative gamma-detecting probe or gamma-scanning techniques in patients at an earlier time post-infusion of radiolabeled MAb than is currently possible using intact MAb" (p. 102, Col. 2, ¶3).

The rejection was maintained in the Office Action of 7/1/11 as follows:

"Applicants' allegations on pp. 13-17 of the Response of 4/14/11 have been considered and not found persuasive.

a) Applicants allege the low serum half-life in Slavin-Chiorini teaches against the use of CH2-free antibodies as a modification of Herman's constructs - this view is also supported by the half-lives reported in Slavin-Chiorini on page 102, left-hand column, third paragraph (T1/2 = 7.8 hours is indicated as a "fast plasma clearance rate"); the advantage for certain "clinical protocols," as taught in Slavin-Chiorini, appear to be for diagnostic clinical protocols, since nothing else is mentioned, and since the diagnostics discussed in Slavin-Chiorini clearly are clinical. The rejection has therefore not reconciled the noted incompatibility of Herman and Slavin-Chiorini.

Response to Arguments

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (MPEP 2141.02).

Slavin teaches four advantages to removing the CH2 domain, namely, i) faster clearance rate, ii) more rapid tumor targeting, iii) reduced non-specific immunogenicity, and iv) lack of metabolic uptake in normal tissues. Slavin teaches that more rapid tumor targeting and lack of metabolic uptake in normal tissues are desired endpoints for recombinant antibody technology in "clinical situations" (p. 102, Col. 1, ¶ 1). Slavin teaches on p. 102, Col. 2:

"Further testing is required to determine the potential clinical utility of the cB72.3ΔCH2 in the light of its lower tumor binding as compared with cB72.3. However, the faster clearance rate, more rapid tumor targeting and lack of metabolic uptake in normal tissues demonstrated with the iodine-labeled CH2 domain-deleted cMAb may be an advantage for certain clinical protocols. For example, an antibody with these characteristics may be useful in instances in which the exposure of normal tissues to a radionuclide conjugated to an MAb needs to be minimized. A cMAb with a faster clearance rate may also be less likely to elicit an immune response in a patient, thereby allowing

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multiple and/or higher dosages of a cMAb to be administered. The cMAbACH2 may also be optimal for conjugation with radioisotopes with shorter half-lives, and allow for the efficient use of the intraoperative gamma-detecting probe or gamma-scanning techniques in patients at an earlier time post-infusion of radiolabeled MAb than is currently possible using intact MAb."

The examiner submits that Slavin's insight and disclosure was not contrary to the understandings and expectations of Herman, to the extent that Slavin teaches numerous advantages of removing CH2 from the antibody construct for use in "clinical situations" where in vivo delivery of the antibody was the endpoint.

If clearance rate is a inventive feature of the claimed antibody structure, none of the instant claims even contain such language. If the clinical utility is diagnostic versus therapeutic of the claimed antibody structure, none of the instant claims even contain such language.

b) Applicants allege the results from Fredriksen et al. 2006 (a copy is enclosed; cited by Examiner 04- 10- 2008) show that vaccibodies are present in serum after 5 months from one single DNA immunization, of the paragraph bridging pages 2 and 3 (170 days > 5 months); it does not seem that this could be expected from the cited prior art.

Response to Arguments

The examiner submits that Slavin's insight and disclosure was not contrary to the understandings and expectations of Herman, to the extent that Slavin teaches numerous advantages of removing CH2 from the antibody construct for use in "clinical situations" where in vivo delivery of the antibody was the endpoint.

If clearance rate is a inventive feature of the claimed antibody structure, none of the instant claims even contain such language. If the clinical utility is diagnostic versus therapeutic of the claimed antibody structure, none of the instant claims even contain such language.

Herman teaches an Fc portion may be a partial Fc portion (e.g., minibody-CH3) [0069]. Herman teaches at [0069]:

"5) the choice of construct will include an Fc portion or partial Fc portion (eg. CH2 or minibody-CH3) or weighted Fc eg. by pegylation (site specific pegylation is well known in the art) or IgG subtype naturally having additional Fc domains (e.g. an IgE) (which Fc if it includes the CH3 is preferably mutated to preclude its binding and/or increase its half-life as is known in the art see U.S. Pat. No. 6,121,022)...".

The examiner has yet to identify where in Herman increasing serum half-life is a requirement or inducement to delete CH2, further wherein according to the hereinabove excerpt, it's an option and is seemingly only achieved by mutating CH3.

Applicants explanation and illustration of the claimed subject on pp. 12-14 of the Response of 9/1/11 is appreciated.

Applicants allegations in response to the outstanding rejection on pp. 14-18 of the Response of 9/1/11 are not found persuasive.

a) Applicants allege "To properly support a rejection for obviousness it would be necessary for Herman to teach the same overall structural organisation of a polypeptide as presently claimed. So, absent any direct and unambiguous disclosure in Herman of a polypeptide having the structure AU - DM' - TU, the presently claimed invention must be unobvious over Herman in view of Slavin-Chiorini. Slavin-Chiorini teaches four

advantages to removing the CH2 domain, namely, i) faster clearance rate, ii) more rapid tumor targeting, iii) reduced non-specific immunogenicity, and iv) lack of metabolic uptake in normal tissues. Slavin teaches that more rapid tumor targeting and lack of metabolic uptake in normal tissues are desired endpoints for recombinant antibody technology in "clinical situations" (p. 102, Col. 1, ¶ 1).

Response to Arguments

In response to applicants' argument that they have discovered the structural organization for the protein encoded by the claimed nucleic acid, applicant is reminded that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005).

Here and again, the examiner emphasizes that Herman in combination with Slavin-Chiorini renders the claimed invention obvious. Herman teaches a multispecific ligand comprises an Fc portion and an Ig hinge portion. An Fc portion may be a *partial Fc portion* (eg. minibody-CH3) (the choice of construct will include an Fc portion or partial Fc portion (eg. *CH2 or minibody-CH3*)) [0069] and to the extent that Slavin-Chiorini teaches numerous advantages of removing CH2 from the antibody construct for

use in "clinical situations" where in vivo delivery of the antibody was the endpoint, the claims are prima facie obvious.

b) Applicants allege Slavin-Chiorini's molecule is a murine antibody analogue used in diagnosis - the reference explicitly teaches that it may be valuable (but that it is not certain) that removal of the CH2 domain in such an antibody will generally decrease serum half-life - it is namely also underscored in Slavin-Chiorini that further testing is necessary and that other doubts as to the usefulness of the CH2 free antibodies are expressed.

Response to Arguments

MPEP 2143.01 Section II states in part:

"Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another." *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).

Here and again, Slavin teaches four advantages to removing the CH2 domain, namely, i) faster clearance rate, ii) more rapid tumor targeting, iii) reduced non-specific immunogenicity, and iv) lack of metabolic uptake in normal tissues. Slavin teaches that more rapid tumor targeting and lack of metabolic uptake in normal tissues are desired endpoints for recombinant antibody technology in "clinical situations" (p. 102, Col. 1, ¶ 1). Slavin teaches on p. 102, Col 2:

"Further testing is required to determine the potential clinical utility of the cB72.3Δ,CH2 in the light of its lower tumor binding as compared with cB72.3. *However, the faster clearance rate, more rapid tumor targeting and lack of metabolic uptake in normal tissues demonstrated with the iodine-labeled CH2 domain-deleted cMAb may be an advantage for certain clinical protocols.* For example, an antibody with these characteristics may be useful in instances in which the exposure of normal tissues to a radionuclide conjugated to an MAb needs to be minimized. A cMAb with a faster clearance rate may also be less likely to elicit an immune response in a patient, thereby allowing multiple and/or higher dosages of a cMAb to be administered. The cMAbACH2 may also be optimal for conjugation with radioisotopes with shorter half-lives, and allow for the efficient use of the intraoperative gamma-detecting probe or gamma-scanning techniques in patients at an earlier time post-infusion of radiolabeled MAb than is currently possible using intact MAb."

"The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." 596 F.2d at 1022, 201 USPQ at 661.).

c) Applicants allege Herman teaches preserving or increasing serum half-life of multi-specific receptors, and further that neither of these two options combine naturally with the decreased half-life reported in Slavin-Chiorini.

Response to Arguments

The examiner resubmits that Herman explicitly teaches partial Fc domains having CH2 or minibody-CH3, which is incontrovertible evidence of its teaching using only a CH3 domain. Wherein the absence of a CH2 domain resulted in several different properties as taught by Slavin-Chiorini, and where the claims are not limited to the intended use, and where depending on the ordinary artisan's intended clinical use of the nucleic acid may be any one or combination of the factors disclosed in Slavin-Chiorini, the grounds for motivation are substantiated. The examiner has taken each reference as a whole in its teachings and finds that the positive outcomes of deleting a CH2 domain are sufficient motivation to prepare constructs having no CH2 domain. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005).

The rejection is maintained.

Conclusion

6. No claims are allowed.
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNN BRISTOL whose telephone number is (571)272-6883. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Misook Yu can be reached on 571-272-0839. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Lynn Bristol/
Primary Examiner
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